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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/530,070

08/29/2005

Dietmar Muller

0740-71

7543

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7590

03/06/2009

THE MAXHAM FIRM

9330 SCRANTON ROAD, SUITE 350

SAN DIEGO, CA 92121

EXAMINER

WENDELL, ANDREW

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/530,070 | <b>Applicant(s)</b><br>MULLER ET AL. |  |
|                              | <b>Examiner</b><br>ANDREW WENDELL    | <b>Art Unit</b><br>2618              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9-16 and 22-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al. (US Pat Pub# 2004/0203903).

As for claim 9, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network (Abstract and Page 15, Para 0163-0165), wherein the SIM card is configured in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both (Sections 0129 and 0165, only users addresses on the friend list are granted permission to communicate with device); and wherein the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of the mobile communication network (Page 15, Para 0163-0165, teaches storing friend list on a removable memory such as a SIM card).

As for claims 10 & 28-32, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein said SIM card is

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designed as a Telematic SIM card and wherein the SIM card supports other services that are typically not understood to be Telematic services (Page 1, Para 0003-0004 and Section 0039).

As for claims 11-12, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the destination and source addresses are phone numbers, URLs (Uniform Resource Locator) or APN's (Access Point Name) (Page 5, Para 0067; Page 6, Para 0077; Page 14, Para 0155; and Page 15, Para 0163- 0165).

As for claims 13-16, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card only supports defined telecommunication services (Abstract; Sections 0039 and 0043; Page 12, Para 0129; and Page 15, Para 0163-0165).

As for claims 22-27, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card encompasses more than one different subscriber relationship, wherein the use of the SIM card is assigned according to the originator principle to the respective subscriber relationship (Abstract; Page 2, Para 0045; Page 3, Para 0051; Page 4, Para 0056; Page 5, Para 0066; Page 9, Para 0104; Page 12, Para 0129; and Page 15, Para 0163-0165).

Regarding claim 33, process claim 33 is rejected for the same reason as apparatus claim 9 since the recited elements would perform the claimed steps.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (US Pat Pub# 2004/0203903) in view of Lipsanen et al. (US Pat Pub# 2002/0059614).

As for claims 17-21, Wilson et al. teaches the limitations in claims 9-13. Wilson fails to teach a virtual private network.

Lipsanen teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the mobile phone subscriber relationship associated with the SIM card can only be operated within a defined virtual private network (Page 4, Para 0040-0042 and Page 6, Para 0065, VPN certificates in SIM card).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the storing of VPN information on a SIM card as taught by Lipsanen into Wilson's apparatus in order to receive communication services easier (Section 0009).

***Response to Arguments***

| Applicant's Remarks | Examiner's Response |
|---------------------|---------------------|
|---------------------|---------------------|

|                                                                                                                                                                                                                                                     |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>“Wilson does not suggest configuring a SIM card in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both, as required by claim 9.”</p>                              | <p>Examiner believes applicant is reading more into the claims than present and reading the reference cited as a whole instead of focusing on the cited sections in the rejection. As stated clearly in the rejection, Sections 0129 and 0165 of Wilson teaches only users addresses on the friend list are granted permission to communicate with device. The permission to communicate is a define destination or address (i.e. number). If the number is blocked/denied (i.e. not on list) then it is defined that it can not be connected. Therefore, there is a defined destination and/or address based on the list and Wilson clearly teaches the limitations.</p> |
| <p>“Wilson does not suggest limiting use of a mobile telecommunications terminal device by using in the terminal device a SIM card that permits connections only to defined destination or source addresses, or both, as required by claim 33.”</p> | <p>The claims do not recite a limiting use in the limitations (i.e. again applicant reading more into the claims). However, as explained above, the list limits the use of addresses and destinations to which the device can be connected to and</p>                                                                                                                                                                                                                                                                                                                                                                                                                     |

|                                                                                                                                                                                                                                                                                 |                                                                                                                                                                                                                                                            |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|                                                                                                                                                                                                                                                                                 | communicate with (Sections 0129 and 0165 of Wilson).                                                                                                                                                                                                       |
| “Wilson is directed to managing permissions for distributing mobile-device-location information, not permissions for connecting mobile devices to destination and/or source addresses, as required by independent claims 9 and 33 of the present application.”                  | Sections 0129 and 0165 of Wilson teaches if the user sets an address/destination in the deny list that is the same as not having permission to connect with that specific address. Again, the claims are broad and Wilson clearly teaches the limitations. |
| “Wilson does not suggest that the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of a mobile communication network, as required by claims 9 and 33.”                            | Clearly in sections 0129 and 0163-0165 of Wilson it teaches storing this information on a SIM card.                                                                                                                                                        |
| “Wilson does not suggest limiting the destination and/or source addresses to which a terminal device of a mobile telecommunications network can be connected, as required by claims 9 and 33. Instead, Wilson discloses limiting the distribution of information indicating the | See above responses. Examiner suggest to applicant to make claims more specific to overcome the prior art of record instead of assuming examiner can read things from applicant’s specification into the claims.                                           |

|                                                                                                     |                                                                                                                                                                                                                                                                                                                                                                                                                       |
|-----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| current location of a user's wireless phone.”                                                       |                                                                                                                                                                                                                                                                                                                                                                                                                       |
| “The combined teachings of Wilson and Lipsanen neither describe nor suggest the present invention.” | In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See <i>In re Keller</i> , 642 F.2d 413, 208 USPQ 871 (CCPA 1981); <i>In re Merck &amp; Co.</i> , 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Lipsanen was not used in the rejection of claims 9 and 33. |

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW WENDELL whose telephone number is (571)272-0557. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Wendell/  
Examiner, Art Unit 2618

/Nay A. Maung/  
Supervisory Patent Examiner, Art  
Unit 2618

9/25/2009